

REMARKS

By the present amendment, claims 15, 17, 19, 32, 33, 35, 36, 40, 41, 43, and 44 have been amended to obviate the examiner's objections thereto and/or to further clarify the concepts of the present invention. Support for the amendments to independent claims 15 and 19 may be found, among other places, on page 20, lines 8-11 of the subject specification. Dependent claims 34 and 42 have been cancelled herein.

It is submitted that these amendments to the claims are helpful in distinguishing the subject claims over the cited prior art and do not raise new issues which would require further consideration and/or search. In addition, it is submitted that such amendments place the application in better form for appeal by materially reducing or simplifying the issues for appeal. Furthermore, no additional claims are presented without cancelling a corresponding number of finally rejected claims. In view of the above, it is submitted that entry of the above amendments is in order and such is respectfully requested.

Initially, applicants wish to make of record the telephone interview conducted between Examiner Olsen and the undersigned on September 8, 2004. During the interview, the proposed claim amendments as contained in the partial Draft Amendment as forwarded by facsimile on September 3, 2004, were thoroughly discussed. At the conclusion of the interview, the examiner indicated that claim 15 as presented above, which corresponds to claim 15B of the draft Amendment with further modifications,

probably would be acceptable and would place the claims in condition for allowance. It is desired to thank the examiner for the courtesies extended during the interview.

In the Office Action, claims 33-36 and 41-44 were objected to under 37 CFR § 1.75 as being substantial duplicates of claim 29-32 and 37-40. As noted above, claims 32, 33, 35, 36, 40, 41, 43, and 44 have been amended herein and it is submitted that these amendments obviate any allegation that there is similar subject matter being claimed. Withdrawal of the objection is therefore requested.

Claim 17 was rejected under the second paragraph of 35 USC § 112 as being indefinite. In particular, it appeared that one quotation mark still remained in this claim when it was intended to delete all such marks from the claims in the last response. This matter has been corrected in claim 17. Accordingly, withdrawal of the rejection under the second paragraph of 35 U.S.C. § 112 is respectfully requested.

Claims 15, 19, 33-36 and 41-44 were rejected under 35 USC § 102(b) as being anticipated by the previously cited patent to Pethig et al. In making this rejection, it was asserted that the Pethig et al patent teaches a method for separating substances contained in a liquid where the fluid is subjected to negative dielectrophoretic force utilizing vacant spaces. In so doing, it was asserted that any number of the spaces between the electrodes would read on the claimed vacant space. Reconsideration of this rejection in

view of the above claim amendments and the following comments is respectfully requested.

As discussed in the telephone interview, it is submitted that the subject matter of independent claims 15 and 19 patentably distinguishes over the disclosure of the Pethig et al patent. More specifically, a important and distinguishing feature of the subject invention is that the electrode includes an interior hollow or vacant space as shown in Figures 3-5 and 13 of the application. This electrode configuration is to be contrasted with the electrode according to the cited Pethig et al patent as shown in Figure 6, for example, which does not include such an interior hollow or vacant space.

Thus, there are structural differences between the electrodes according to the present invention and those as shown by the Pethig et al patent. Independent claims 15 and 19 now define the vacant space in terms of structure for the electrode where the vacant space is described by its periphery being formed by only one electrode. That is, the periphery of the vacant space is not defined by the second electrode. Therefore, it is submitted that the claims as amended adequately define the subject invention over the cited patent and should be in condition for allowance.

For the reasons stated above, withdrawal of the rejection under 35 U.S.C. § 102(b) and allowance of claim 15, 19, 33-36 and 41-44 over the cited Pethig et al patent are respectfully requested.

In addition, the remainder of the claims were rejected in a series of obviousness type rejections based on the above patent to Pethig et al. Specifically, claim 16 was rejected under 35 USC § 103(a) as being unpatentable over the above patent to Pethig et al in view of the patent to Benecke et al, the latter being asserted to teach the use of a lid for defining a gap between the electrodes. Claims 17 and 18 were rejected under 35 USC § 103(a) as being unpatentable over the above patent to Pethig et al in view of the patents to Benecke et al and Parton et al, and claims 20 and 21 were rejected as being unpatentable over the patent to Pethig et al in view of the patent to Parton et al, the latter patent being asserted to teach a dielectrophoretic device where the substance being analyzed can be complexes of particles. Reconsideration of each of these rejections in view of the above claim amendments and the following comments is respectfully requested.

It is submitted that the same considerations as were set forth above with respect to the rejection of independent claims 15 and 19 would also apply to these rejections. Thus, the above remarks relative to the teaching deficiencies of the Pethig et al patent are reiterated with regard to these rejections. It is submitted that neither of the cited patents

to Benecke or Parton et al supply these deficiencies in that none teach or suggest the use of an electrode having a vacant space as presently defined in the subject claims.

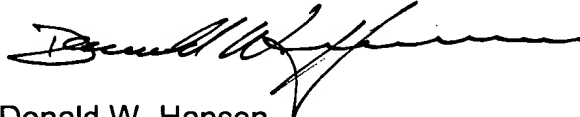
For the reasons stated above, withdrawal of the rejections under 35 U.S.C. § 103(a) and allowance of claims 16-18, 20 and 21 over the cited patents are respectfully requested.

In view of the foregoing, it is submitted that the subject application is now in condition for allowance and early notice to that effect is earnestly solicited.

In the event this paper is not timely filed, the undersigned hereby petitions for an appropriate extension of time. The fee for this extension may be charged to Deposit Account No. 01-2340, along with any other additional fees which may be required with respect to this paper.

Respectfully submitted,

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